

Appl. No.: 09/981,511
Amdt. dated October 2, 2003
Reply to Office action of August 22, 2003

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Office Action dated August 22, 2003. In that Action, the Examiner rejected claims 1-9, 11-13 and 20-24 as allegedly unpatentable over admitted prior art in view of *Lin* (U.S. Patent No. 6,412,546).

With this Response to Office Action, Applicants amend claims 11 and 20, and add new claims 25-30. Applicants believe the pending claims are allowable over the art of record and respectfully request reconsideration.

I. CLAIM REJECTIONS

Claim 1 is directed to a component restraint system that is used to secure an electronic component to a circuit board that comprises, *inter alia*, a post having a plurality of stop surfaces that allows a clip, when inserted on the post, to variably compress a spring mounted thereon. Claim 11 is directed to an electronic assembly that comprises, *inter alia*, a plurality of clips configured to engage one of the posts in a plurality of different positions to compress the springs to a plurality of different compressive forces. Applicants amended claim 11 to remove the "adapted to" terminology so that the Examiner will consider the functional limitation regarding the clips. Claim 20 is directed to a computer system that comprises, *inter alia*, a plurality of clips (one clip per post) wherein each of the clips has clip members that are pushed apart to engage the post in a plurality of different positions and thus variably compressing the springs. Claim 20 was amended to specifically recite the functional limitation regarding variably compressing the springs. The Examiner rejected all the pending claims as allegedly obvious over Applicants' Background section in view of *Lin*.

The case for obviousness in the Office Action of August 22, 2003 is too tenuous. In the Office Action the *Lin* reference is modified (without textual support for the modification) to include more than one stop surface. The modified *Lin* reference is combined with Applicants' Background section (again without textual support in either reference for the combination), and then an inherent characteristic regarding variably compressing is found in the fictional structure

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born out of the modified and combined disclosures. Each of these steps in forming the obviousness rejection will be addressed in turn.

"The mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification.**" *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added). *Lin* does not teach, suggest or even imply the desirability of modifying *Lin*'s posts 66 to comprise plurality of stop surfaces. For this reason alone, the proposed modification of *Lin* to a system having multiple stops is not proper.

With regard to the suggestion to combine references, *In re Fritch* provides further guidance:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. **Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.**

Id. (italics original, bolding added). Applicants respectfully submit that their Background section and *Lin* are not properly combined. Neither the Applicants' Background section nor *Lin* teach or suggest the combination. Moreover, Applicants submit there is no incentive to combine their Background section with the *Lin* reference which fails to teach the desirability, or a structure, for variably compressing a spring.

Finally, the Office Action states, "it is deemed inherent that the combination's plurality of stop surfaces would permit the spring to be variably compressed." Office Action dated August 22, 2003, page 3. Applicants respectfully submit that use of inherency in the context of modified and combined disclosures is not proper. With regard to inherency, the MPEP states that "[t]he express, implicit, and Inherent disclosure **of a prior art reference** may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103." MPEP 2112 (emphasis added).

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is **inherently present in the thing**

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described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that the certain thing may result from a given set of circumstances is not sufficient.

Id. (citing *In re Robertson*, 169 F.3d 743,745 (Fed. Cir. 1999) (emphasis added).

Applicants respectfully submit that the alleged inherent property is not "present in the thing described in the reference." How can there be an inherent property in the *Lin* disclosure of a structure that itself is not textually present? Applicants respectfully submit that *Lin* fails to "make clear that the missing descriptive matter is necessarily present in the thing described."

Thus, to arrive at obviousness, the Office Action makes a modification to *Lin*, which modification is not taught or fairly suggested in *Lin*. The Office Action then combines the improperly modified *Lin* reference and teachings from the Applicants' Background section; however, there is no teaching in either the Applicants' Background section or in *Lin* to make the combination. Finally, the Office Action takes the improperly modified *Lin* reference with the questionable combination of *Lin* and Applicants' Background section, and finds an inherent characteristic regarding variably compressing a spring. Applicants respectfully submit that this set of unsupported modifications and combinations, in combination with an alleged inherent teaching of a structure that does not exist in either *Lin* or Applicants' Background section, is too tenuous to support an obviousness rejection.

Based on the foregoing, Applicants respectfully submit that all the pending claims are allowable.

II. NEW CLAIMS

With this Response to Office Action, Applicants submit new claims 25-30. Each of these claims recites limitations not found in the cited art.

III. CONCLUSION

Applicants respectfully request reconsideration and allowance of the pending claims. If the Examiner feels that a telephon conference would

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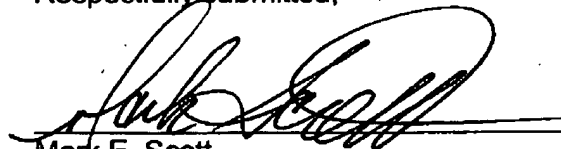
expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Hewlett-Packard Company Deposit Account Number 08-2025 and enter any time extension(s) necessary to prevent this case from being abandoned.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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